

Remarks/Arguments

Applicants have received and carefully reviewed the Final Office Action of the Examiner mailed October 22, 2003. Claims 1-20 stand rejected. This Amendment assumes that the Response-After-Final filed on December 17, 2003 was not entered by the Examiner. Reconsideration and reexamination are respectfully requested.

The undersigned would like to thank the Examiner for the courtesies extended during the telephonic interview of December 8, 2003. During that interview, the undersigned pointed out that the Section 112, first paragraph, rejection was improper, citing, for example, page 2, lines 1-13 and page 7, line 6 to page 8, line 2 of the present specification. In addition, the undersigned point out that McNair et al. do not suggest, among other things, a management system for a building or for one or more rooms in a building, wherein the signals are transmitted at at least two different frequencies within a frequency range (54), with at least one of these frequencies being outside a defined partial frequency range (55) of the frequency range (54), wherein the defined partial frequency range (55) of the frequency range (54) is defined as including a portion of the frequency range (54) that is more heavily used than other portions of the frequency range (54) by devices in or near the building.

During the interview of December 8, 2003, *the Examiner requested that Applicants file this Response requesting reconsideration, and that the Examiner would in return withdraw the final rejection of the pending claims.* That is, it appeared that the Examiner recognized that the present claims were patentable over McNair et al., and that the present claims were fully supported by the present specification.

An Advisory Action was mailed on January 9, 2004. The Examiner indicated in the Advisory Action that the Response-After-Final would not be entered because it raises the issue of new matter. In the note attached to the Advisory Action, the Examiner states that the phrase "more heavily used" is not in the specification, and that the specification only describes that different frequencies are being operated inside the building and outside the building. The Examiner did not raise or mention any art rejections.

After carefully reviewing the Examiner's comments, Applicants must respectfully disagree that the phrase "more heavily used" is not supported by the present specification.

First, the Examiner appears to suggest that since the exact phrase “more heavily used” is not used in the specification, the claims cannot be adequately supported by the present specification. However, the use of the exact phrase in the specification is simply not required (see, for example, MPEP § 2163 (I)(b); *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”)).

The Examiner also states that “[t]he specification only describes different frequencies are being operated inside the building and outside the building”. This is simply not the case. In the Response-After-Final (citing page 2, lines 1-13 and page 7, line 6 to page 8, line 2), and during the telephone interview of December 8, 2003, the undersigned pointed out that the specification fully supports the present claims. For example, the undersigned point out that present specification states:

A partial frequency range 55 of the frequency range 54 is usually already commercially used in some other way. Thus, most units operated in a building and communicating by radio transmit in this partial frequency range 55.

(see, specification, page 7, lines 15-19) (Emphasis Added). The question is, then, does this language (and other language in the specification) support the present claims. Claim 1 recites:

... wherein the defined partial frequency range (55) of the frequency range (54) is defined as including a portion of the frequency range (54) that is more heavily used than other portions of the frequency range (54) by devices in or near the building.

Applicants do not see how this element of claim 1 cannot be supported by the present specification. As noted above, the present specification states “most units operated in a building and communicating by radio transmit in this partial frequency range 55” (see, specification, page 7, lines 15-19) (Emphasis Added). Thus, partial frequency range 55 is clearly “more heavily used”, as recited in claim 1. The adjective “heavily” means “a lot or to a great degree” (see Cambridge Learner’s Dictionary). Since “most units operated in a building and communicating by radio transmit in this partial frequency range 55”, it

is only logical to conclude that the partial frequency range 55 is used to a greater (more) degree.

To date, no satisfactory explanation of the Examiner's position has been set forth in an Office Action (or Advisory Action). Only conclusory statements have been provided by the Examiner, without any substantive explanation of the reasoning behind the conclusion. This is clearly improper.

Applicants would like to remind the Examiner that:

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 (“[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”). However, when filing an amendment an applicant should show support in the original disclosure for new or amended claims. See MPEP § 714.02 and § 2163.06 (“Applicant should * * * specifically point out the support for any amendments made to the disclosure.”).

(see, MPEP § 2163 (II)(3)(b)). To date, Applicants believe that the Examiner has failed to present sufficient evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. In the Advisory Action, the Examiner merely states that the specification “only described different frequencies are being operated inside the building or outside the building”, which as pointed out above, is simply not the case. In contrast, Applicants have specifically pointed out where support exists in the present specification for the amended claims.

For the reasons given above, Applicants believe the pending claims are fully supported by the present specification. Despite this, Applicants have amended claim 1 to replace “more heavily used” with “more commonly used”. As noted above, the present specification states “most units operated in a building and communicating by radio transmit in this partial frequency range 55” (see, specification, page 7, lines 15-19) (Emphasis Added). Thus, partial frequency range 55 is clearly “more commonly used”,

as recited in claim 1. Similar amendments have been made to the other independent claims. These amendments are believed to broaden the scope of the pending claims.

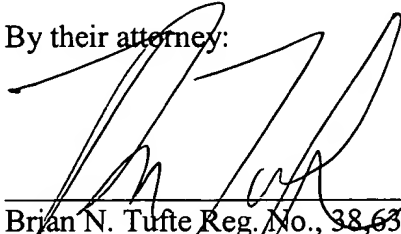
As noted above, the undersigned is under the impression that only the 35 U.S.C. 112, first paragraph, rejection remains, and that the Examiner agrees that if the pending claims are supported by the present specification, they are patentable over the cited prior art. If this is not the case, Applicants hereby incorporate by reference the remarks presented in Applicants' previous response filed on September 5, 2003, which show why the pending claims are patentable over the cited prior art. If the Examiner disagrees, Applicants respectfully request that the Examiner specifically point out where in the prior art each and every element of the claims are disclosed or suggested.

In view of the foregoing, all pending claims 1-20 are believed to be in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner would like to discuss the application or its examination in any way, please call the undersigned attorney at (612) 677-9050.

Respectfully Submitted,

Bienert et al.

By their attorney:



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